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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,912	02/28/2002	Robert D.P. Hei	163.1440USU1	1677
23552	7590	11/30/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PUTTLITZ, KARL J	
			ART UNIT	PAPER NUMBER
			1621	
DATE MAILED: 11/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/086,912

Applicant(s)

HEI ET AL.

Examiner

Karl J. Puttlitz

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

The rejection under section 103 is maintained and repeated below. Applicant's remarks in connection with this ground of rejection are also addressed.

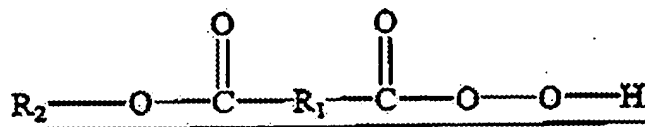
#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 213.

The claims invention, as amended, is drawn to a stabilized ester peroxycarboxylic acid composition comprising: an ester peroxycarboxylic acid compound of the formula



[See definitions in claim 1]

and about 0.5 wt% to about 80 wt % C2 or higher alcohol; the C2 or higher alcohol being suitable for use in food products, for cleaning or sanitizing food processing equipment or materials, for use in a health-care environment or a

Art Unit: 1621

combination thereof, C2 or higher alcohol being effective to stabilize the ester-peroxycarboxylic acid without an additional stabilizer and maintain at least about 30 % of antimicrobial activity of the composition for at least about 3 months.

WO 213 suggests the claimed composition within the meaning of § 103.

Specifically, the claimed composition is suggested by Example 1, comprising esters of peracids from a starting material of ethanol. The reference also teaches that up to 10 % wt of the ethanol is residual in the final composition. See page 6, lines 1-4.

Specifically, Example 1 teaches that a solution containing 14,04 g glutaric acid, 9,79 g ethanol, 17,65 g concentrated hydrogen peroxide (85,5% wt), 1 g concentrated sulphuric acid, 57,52 g demineralised water, 0,1 g p-hydroxy benzoic acid, 0,17 g of 1-hydroxyethane-1, 1-diphosphonic acid (Briquest ADPA 60A) was prepared with stirring, and allowed to reach equilibrium. The molar ratio of ester peracid to monocarboxylic peroxycarboxylic acid found in the system was 1:8, measured by HPLC.

The difference between WO 213 and the claimed inventions is that WO 213 does not teach the invention with particularity so as to amount to anticipation (See M.P.E.P. § 2131: "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).). However, based on the above, WO 213 teaches the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie*

Art Unit: 1621

obvious to one of ordinary skill (the prior art reference teaches or suggests all the claim limitations with a reasonable expectation of success. See M.P.E.P. § 2143).

Applicant argues that independent claim 1 also recites the buffer consists of citric acid and citrate salt, of phosphoric acid and phosphoric acid salt, or of boric acid and boric acid salt. The reference teaches that the solutions may contain phosphates. See page 6, lines 30-35.

Applicant argues that the reference teaches a different pH range. In this regard, the reference teaches that pH values of at most 5 are valued. Therefore, the claimed pH range of about 4 to about 7 are contemplated by the reference, and without a showing of unexpected results, the claimed pH range is prima facie obvious.

Applicant also argues that the reference does not teach the 4 to 10 wt % of the peroxycarboxylic acid or the 0.5 to 80 wt % C2 or higher alcohol. However, the reference teaches that the alcohol is in the range of 0.05 to 45 % (see page 4) and the peracid compound is preferably at most 25 or 30% (see page 3).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1621

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

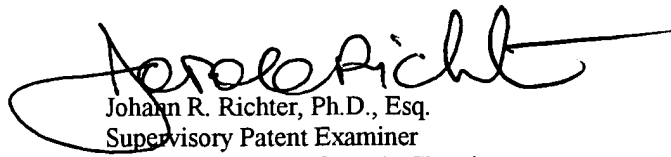
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at telephone number (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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